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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,603	08/01/2003	Lionel Vedrine	P-4604PIC1	4329

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EXAMINER

MITCHELL, TEENA KAY

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/632,603

Applicant(s)

VEDRINE ET AL.

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-21, 23-66 and 73-76 is/are rejected.
- 7) ☒ Claim(s) 14, 22, 67-72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

While applicant in the first paragraph of the disclosure list that the instant application is a Continuation of application 09/829,843, the current status of the 09/829,843 application is missing, also a listing of the other related applications (e.g., 09/417,346; 09/993,098).

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. While the examiner has reviewed all patents listed in parent applications related to the instant application, however, if applicant desires the information to be printed on any patent that may issue from the instant application applicant must submit an appropriate 1449, listing such references. (MPEP 609).

### ***Specification***

The abstract of the disclosure is objected to because it is longer than 150 words (CFR 1.72). Correction is required. See MPEP § 608.01(b).

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### ***Claim Objections***

Claim 76 is objected to because of the following informalities: Claim 76 is dependent from claim 1 which is an apparatus claim. The examiner believes applicant intended claim 76 to depend from claim 61, therefore line 1 of claim 76 should be amended to read --in claim 61--. Correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13, 15-21, 23-44, and 50-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,622,721. Although the conflicting claims are not identical, they are not patentably distinct from each other because **Claim 1 of the instant application** limitations can be found in claim 1 of the patent. Claim 1 of the instant application does not include all the elements of claim 1 of the patent. Therefore, the patented claim 1 "anticipates" the application claim 1 (*In re Goodman*, 11 F.3d 1046, 29 USPQ 2010 (Fed. Cir. 1993)). **With respect to claim 2, of the instant application,**

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the limitations can be found in claim 7 of the patent. **With respect to claim 3 of the instant application**, the limitations can be found in claim 8 of the patent. **With respect to claim 4 of the instant application**, the limitations can be found in claim 9 of the patent. **With respect to claim 5 of the instant application**, the limitations can be found in claim 10 of the patent. **With respect to claim 6 of the instant application**, the limitations can be found in claim 11 of the patent. **With respect to claim 7 of the instant application**, the limitations can be found in claim 12 of the patent. **With respect to claim 8 of the instant application**, the limitations can be found in claim 13 of the patent. **With respect to claim 9 of the instant application**, the limitations can be found in claim 14 of the patent. **With respect to claim 10 of the instant application**, the limitations can be found in claim 15 of the patent. **With respect to claim 11 of the instant application**, the limitations can be found in claim 16 of the patent. **With respect to claim 12 of the instant application**, the limitations can be found in claim 2 of the patent. **With respect to claim 13 of the instant application**, the limitations can be found in claim 1 of the patent. **With respect to claim 15 of the instant application**, the limitations can be found in claim 1 of the patent. **With respect to claim 16 of the instant application**, the limitations can be found in claim 2 of the patent. **With respect to claim 17 of the instant application**, the limitations can be found in claim 1 of the patent. **With respect to claim 18 of the instant application**, the limitations can be found in claim 1 of the patent. **With respect to claim 19 of the instant application**, the limitations can be found in claim 3 of the patent. **With respect to claim 20 of the instant application**, the limitations can be found in claim 4 of the

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patent. **With respect to claim 21 of the instant application,** the limitations can be found in claim 5 of the patent. **With respect to claim 23 of the instant application,** the limitations can be found in claim 6 of the patent. **With respect to claim 24 of the instant application,** the limitations can be found in claim 1 of the patent. **With respect to claim 25 of the instant application,** the limitations can be found in claim 2 of the patent. **With respect to claim 26 of the instant application,** the limitations can be found in claim 1 of the patent. **With respect to claim 27 of the instant application,** the limitations can be found in claim 1 of the patent. **With respect to claim 28 of the instant application,** the limitations can be found in claim 1 of the patent. **With respect to claim 29 of the instant application,** the limitations can be found in claim 1 of the patent. **With respect to claim 30 of the instant application,** the limitations can be found in claim 3 of the patent. **With respect to claim 31 of the instant application,** the limitations can be found in claim 4 of the patent. **With respect to claim 32 of the instant application,** the limitations can be found in claim 5 of the patent. **With respect to claim 33 of the instant application,** the limitations can be found in claim 6 of the patent. **With respect to claim 34 of the instant application,** the limitations can be found in claim 7 of the patent. **With respect to claim 35 of the instant application,** the limitations can be found in claim 8 of the patent. **With respect to claim 36 of the instant application,** the limitations can be found in claim 9 of the patent. **With respect to claim 37 of the instant application,** the limitations can be found in claim 10 of the patent. **With respect to claim 38 of the instant application,** the limitations can be found in claim 11 of the patent. **With respect to claim 39 of the instant application,**

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the limitations can be found in claim 12 of the patent. **With respect to claim 40 of the instant application**, the limitations can be found in claim 13 of the patent. **With respect to claim 41 of the instant application**, the limitations can be found in claim 14 of the patent. **With respect to claim 42 of the instant application**, the limitations can be found in claim 15 of the patent. **With respect to claim 43 of the instant application**, the limitations can be found in claim 16 of the patent. **With respect to claim 44 of the instant application**, the limitations can be found in claims 1, 2, and 10 of the patent. It would have been obvious to one of ordinary skill in the art at the time the invention was made that in the instant application claim the limitations of "preselected axial distance corresponding to half the distance that said stopper is capable of moving within said barrel to administer about half of the substance contained by said syringe barrel" based on the patent claim 1 "a portion of the substance corresponding to a dosage of the substance" inasmuch as a portion of the substance is delivered it would be obvious to one of ordinary skill in the art that that a portion which constitutes a dose could be half the substance in the barrel. **With respect to claim 50 of the instant application**, the limitations can be found in claim 6 of the patent. **With respect to claim 51 of the instant application**, the limitations can be found in claim 7 of the patent. **With respect to claim 52 of the instant application**, the limitations can be found in claim 1 of the patent. **With respect to claim 53 of the instant application**, the limitations can be found in claim 9 of the patent. **With respect to claim 54 of the instant application**, the limitations can be found in claim 10 of the patent. **With respect to claim 55 of the instant application**, the limitations can be found in claim 11

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of the patent. **With respect to claim 56 of the instant application**, the limitations can be found in claim 12 of the patent. **With respect to claim 57 of the instant application**, the limitations can be found in claim 13 of the patent. **With respect to claim 58 of the instant application**, the limitations can be found in claim 14 of the patent. **With respect to claim 59 of the instant application**, the limitations can be found in claim 15 of the patent. **With respect to claim 60 of the instant application**, the limitations can be found in claim 16 of the patent.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-24 of U.S. Patent No. 6,382,204. Although the conflicting claims are not identical, they are not patentably distinct from each other because **Claim 44 of the instant application** limitations can be found in claim 19 of the patent. However the patented claim is more specific than the instant application claim 44. Therefore, the patented claim 19



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"anticipates" the application claim 44. *In re Goodman*, 11 F.3d 1046, 29 USPQ 2010 (Fed. Cir. 1993). **With respect to claim 45 of the instant application**, the limitations can be found in claim 20 of the patent. **With respect to claim 46 of the instant application**, the limitations can be found in claim 19 of the patent. **With respect to claim 47 of the instant application**, the limitations can be found in claim 21 of the patent. **With respect to claim 48 of the instant application**, the limitations can be found in claim 22 of the patent. **With respect to claim 49 of the instant application**, the limitations can be found in claim 23 of the patent. **With respect to claim 50 of the instant application**, the limitations can be found in claim 24 of the patent.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 61-66 and 73-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,530,371. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 61 of the instant

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**application**, limitations can be found in claim 1 of the patent, except the patented claim uses the language "first nostril" and "second nostril". One of ordinary skill in the art at the time the invention was made would know that in claim 61 the use of "said nostril" and "into said other nostril" would constitute the first and second nostril of a user. **With respect to claim 62 of the instant application**, the limitations can be found in claim 2 of the patent. With respect to claim 63 of the instant application, the limitations can be found in claim 3 of the patent. **With respect to claim 64 of the instant application**, the limitations can be found in claim 4 of the patent. **With respect to claim 65 of the instant application**, the limitations can be found in claim 5 of the patent. With respect to claim 66 of the instant application, the limitations can be found in claim 6 of the patent. **With respect to claims 73-76 of the instant application**, one of ordinary skill in the art at the time the invention was made would have found in obvious to select any of the claimed substances claimed based on the needs of the individual user and the type of treatment required because all listed substances are well known in the respiratory art for delivery via the nasal area.

***Allowable Subject Matter***

Claims 14, 22, and 67-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

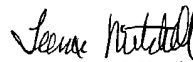
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (703) 308-

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4016. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Teena Mitchell  
Examiner  
Art Unit 3743  
September 4, 2004